UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,007	01/31/2001	Jose Alejandro Rueda	84201-502 ADB	2302

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	**Applicant(s)**
Office Action Summary	09/774,007	RUEDA ET AL.
	Examiner	**Art Unit**
	Dohm Chankong	2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 May 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>5/7/2001</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-19 are presented for examination.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.   Claim 7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

    a.   Claim 7 recites the limitation "the standard OS functions and drivers" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly

from an international application filed before November 29, 2000. Therefore, the prior art

date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the

AIPA (pre-AIPA 35 U.S.C. 102(e)).

5.   Claims 1-3, 5-7, 11, 12, 14, 15, 17, 19 are rejected under 35 U.S.C 102(e) as being anticipated

by Redlich, U.S Patent No. 6,591,306.

6.   As to claim 1, Redlich teaches an apparatus for connecting a portable computer to a

remote site for data communication there between (abstract) comprising:

        a LAN having a plurality of connection ports each for receiving connection to a

portable computer for data communication between the LAN and the portable computer

(Figure 8, items 400, 210, 410);

        the LAN having a predetermined domain identifier for identification of computers

connected to the LAN (column 7, lines 45-61 and column 8, lines 35-41 – where the domain

name/corresponding IP address is the domain identifier).

        a communication computer (abstract, Figures 9 and 10 – where the access router is the

communication computer);

        the communication computer having a LAN connection connected to the LAN for

communication of data between the LAN and the communication computer (Figure 10 and

column 14, lines 20-48);

the communication computer having a network connection for connection to the

remote site for communication of data between the communication computer and the remote

site (Figure 10, column 14, lines 20-48);

the communication computer having designated IP address for use in communication

with the remote site (column 16, lines 15-28 – where the "care-of" IP address is equivalent to a

designated IP address);

the communication computer being programmed to be responsive to messages using

the predetermined domain identifier to receive a data transmission transmitted from a

respective one of a plurality of computers connected to the LAN, to communicate the data

transmission to the remote site using the designated IP address, to receive response data from

the remote site and to transmit the response data to the respective computer (column 6, lines

5-20 and column 8, lines 35-41 – where the router is the communication computer, the

gateway IP is its domain identifier);

the communication computer being further programmed to be responsive to messages

using a domain identifier different from the predetermined domain identifier from a portable

computer alien to the LAN to receive a data transmission transmitted from the portable

computer when connected to the LAN, to communicate the data transmission to the remote

site using the designated IP address, to receive response data from the remote site and to

transmit the response data to the portable computer (column 10, line 58 to column 11, line 8

and column 18, line 57 to column 19, line 30).

the communication computer being further programmed to be responsive to an ARP

request message using a domain identifier different from the predetermined domain

identifier from a portable computer alien to the LAN, which ARP request message requests identification of the MAC-address of a component of the LAN, to respond providing the MAC-address of the communication computer (column 17, lines 1-64 – where the HW address of the router is equivalent to a MAC address which only defines an address of a node on a network).

7.   As to claim 2, Redlich teaches an apparatus when the ARP request message from the portable computer is a request to identify a proxy server of the LAN, the communication computer is programmed to respond providing the MAC-address of the communication computer (column 17, lines 49-64).

8.   As to claim 3, Redlich teaches an apparatus wherein when the ARP request message from the portable computer is a DNS request which may be a proxy request or a non-proxy request, the communication computer is programmed (column 28, line 56 to column 29, line 20):

to receive and process the message (column 28, lines 56-57);

to attempt to make a determination if the request is a proxy DNS request or a non-proxy request (column 28, lines 56-59);

in the event that the request is determined to be a non-proxy DNS request, to transmit the message to a DNS server to obtain a DNS IP address (column 28, lines 56-64);

in the event that the DNS server provides a valid IP address, to communicate to the portable computer the valid IP address (column 30, lines 62-67);

in the event that the DNS server provides no valid address or in the event that the

request is determined to be proxy DNS request, to provide the portable computer the MAC-

address of the communication computer (column 17, lines 49-64).

9.   As to claim 5, Redlich teaches the apparatus wherein the communication computer is

further programmed, when transmitting the response data to the portable computer to

maintain a table indicative of a port of the portable computer on which the response data is to

be transmitted (column 7, lines 8-18 and column 17, lines 8-11).

10.   As to claim 6, Redlich teaches the apparatus wherein the communication computer is

configured in an architecture to handle duplicate IP addresses from different clients which

have similar TCP/IP parameters by creating a routing table that includes a MAC-address

entry for each client and/or by isolating clients in separate subnets; or mapping them to an

IP address pool including their MAC-address (column 18, lines 48-56 and column 19, lines 16-

30, lines 61-67 and column 20, lines 21-36).

11.   As to claim 7, Redlich teaches the apparatus wherein when the ARP request message

from the portable computer is a request to identify a printer server of the LAN, the

communication computer is programmed to respond providing the MAC-address of the

communication computer and handle the printing job for the client by passing the printing

job to a printer server within or by forwarding it to a printer server in the LAN and wherein

the apparatus further provides printers in the client-side LAN that the client computer can

utilize for printing as a standard service with minimal configuration within the standard OS

functions and drivers (column 29, lines 28-41).

12.   As to claim 11, Redlich teaches the apparatus wherein the communication computer

includes for connection to the LAN a network card and a driver for the network card and is

programmed with a series of levels of program including an Internet Protocol program, an

Applications program, and a Gateway/Proxy program, the Internet Protocol program being

arranged to process only messages directed to the LAN and wherein the communications

computer is programmed (Figure 19, items 941 and 942, column 14, line 20-48, column 17, line

49 to column 18, line 15, lines 42-67 and column 30, lines 30-67).

to receive messages from the portable computer at the network card connected to the

LAN (column 18, lines 39-52);

to translate messages which are addressed to an address alien to the LAN so as to re-

address the messages to be processed by the Internet Protocol program for communication to

the Applications program (column 16, line 66 to column 17, line 11 and column 18, lines 57-67);

and

to communicate with the re-addressed message the original alien address for re-

connection to the message (column 17, lines 8-11).

13.   As to claim 12, Redlich teaches the apparatus wherein the communications computer

is programmed:

to communicate the original alien address by generating a supplementary message for

communication to the Internet Protocol program which includes the alien address (column
21, line 66 to column 22, line 14);

to recombine the re-addressed message with the supplementary message at the
Applications program (column 22, lines 9-25); and

to maintain a table identifying the portable computer and the alien address (column
21, lines 34-41).

14.   As to claim 14, Redlich teaches the apparatus wherein the communications computer
is programmed to:

protect packets from client computers from being seen by other client computers
(column 26, lines 12-21);

enabling VPN services by handling CRC checksums and protocols (column 22, lines
17-25 and column 26, lines 12-21).

15.   As to claim 15, Redlich teaches the apparatus wherein the communications computer
is programmed to:

protect packets from client computers from being seen by other client computers
(column 26, lines 12-21);

enabling VPN services by handling CRC checksums and protocols (column 22, lines
17-25 and column 26, lines 12-21);

16.   As to claim 17, Redlich teaches the apparatus wherein the communication computer is

further programmed to be responsive to a web page request message using a domain

identifier different from the predetermined domain identifier from the portable computer

alien to the LAN to provide to the portable the requested web page when obtained and to add

to the web page so provided an "in-house" start web page specified by the service provider

and generated or retrieved by the communication computer (column 29, line 49 to column 30,

line 5).

17.   As to claim 19, Redlich teaches an apparatus for connecting a portable computer to a

LAN for which the portable computer is not configured comprising:

a LAN having a plurality of connection ports each for receiving connection to a

portable computer for data communication between the LAN and the portable computer

(Figure 8, items 400, 210, 410);

the LAN having a predetermined domain identifier for identification of computers

connected to the LAN (column 7, lines 45-61 and column 8, lines 35-41 – where the domain

name/corresponding IP address is the domain identifier).

a communication computer (abstract, Figures 9 and 10 – where the access router is the

communication computer);

the communication computer having a LAN connection connected to the LAN for

communication of data between the LAN and the communication computer (Figure 10 and

column 14, lines 20-48); and

the communication computer is further programmed:

be responsive to a web page request message using a domain identifier

different from the predetermined domain identifier from the portable computer alien

to the LAN to provide to the portable the requested web page when obtained and to

add to the web page so provided an "in-house" start web page specified by the service

provider and generated or retrieved by the communication computer (column 29, line

49 to column 30, line 5).

Claim Rejections - 35 USC § 103

18.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19.   Claim 4 is rejected under 35 U.S.C 103(a) as being unpatentable over Redlich in view

of David Wolfe, "Designing and Implementing Microsoft Proxy Server", First Edition,

Chapter 11, 1997.

20.   Redlich does not teach an apparatus wherein the attempt to determine if the request is

a proxy DNS request or a non-proxy request is done by the presence of a dot in the http

request.

21.   Wolfe teaches determining if the request is a proxy DNS request or a non-proxy request is done by the presence of a dot in the http request (page 4 of the printout for chapter 11 – where the presence of a dot in "*.netscape.*" differentiates between a proxy or non-proxy address. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include Wolfe's method for distinguishing between proxy and non-proxy requests in Redlich to allow the user to determine which addresses are passed or not passed to the proxy server, thereby allowing administrators extended control over their network.

22.   Claims 8-10 are rejected under 35 U.S.C 103(a) as being unpatentable over Redlich in view of Li et al (hereinafter Li), U.S Patent No. 6,012,088.

23.   As to claim 8, Redlich teaches the apparatus when the ARP request message from the portable computer is a request to identify a server of the LAN, the communication computer is programmed to respond providing the MAC-address of the communication computer and handles the email as required (column 16, lines 45-51, column 17, lines 49-64).

Redlich does not teach that the server is an email server or that the communication computer handles the email by forwarding the message to a LAN email-send program or to an email system within the apparatus.

24.   Li teaches that a server can be implemented as an email server, and that a communication computer handles email by forwarding the message to a LAN email-send

program (Figure 3, item 66 and column 6, lines 42-63). It would have been obvious to one of

ordinary skill in the art to implement Li's email server and system into Redlich to insure

reliability for the user that his message will be properly sent by the network.

25.   As to claim 9, Redlich teaches the apparatus wherein when the ARP request message

from the portable computer is a request to identify a server of the LAN, the communication

computer is programmed to respond providing the MAC-address of the communication

computer and presents all retrieved email to the client computer (column 16, lines 45-51 and

column 17, lines 49-64).

Redlich does not teach that the server is an email server or that the communication

computer retrieves the required email from a remote email server outside any firewalls.

26.   Li teaches that a server can be implemented as an email server and that the

communication computer can retrieve the required email from a remote email server outside

any firewalls (column 6, lines 52-56 and 59-63). It would have been obvious to one of ordinary

skill in the art at the time the invention was made to implement Li's email server and

retrieval method into Redlich to allow users the capability to request and gather email from a

remote server outside of their current LAN.

27.   As to claim 10, Redlich teaches the apparatus wherein the communication computer is

further programmed to be responsive to an ARP request message using a domain identifier

different from the predetermined domain identifier from a portable computer alien to the

LAN, which ARP request message requests identification of the MAC-address of a domain

name server, a gateway server, a proxy server, an email server or other services of the LAN,

to respond providing the MAC-address of the communication computer (column 10, line 32-

44, line 62 to column 11, line 25 and column 17, lines 49-64 – where the gateway IP is used as

the domain identifier) .

28.   Claim 13 is rejected under 35 U.S.C 103(a) as being unpatentable over Redlich, in view

of Enns et al (hereinafter Enns), U.S Patent No. 6,658,010.

29.   Redlich teaches the apparatus wherein the communications computer is programmed:

        to forward requests from portable computers to systems within for processing or

systems within the LAN (column 20, lines 50-61).

        Redlich does not teach that the communications computer is programmed to balance

the load on the network by utilizing a redundant apparatus.

30.   Enns teaches a communications computer programmed to balance the load on the

network by utilizing a redundant apparatus (column 14, lines 25-52). It would have been

obvious to one of ordinary skill in the art at the time the invention was made to implement

Enns load balancing functionality into Redlich's communications computer to more

efficiently utilize and assign bandwidth to the users of the network.

31.   Claims 16 and 18 are rejected under 35 U.S.C 103(a) as being unpatentable over

Redlich, in view of Levy et al (hereinafter Levy), U.S Patent No. 6,466,981.

32.   As to claim 16, Redlich teaches the apparatus wherein the communication computer is

further programmed:

to be responsive to the ARP request message using a domain identifier different from

the predetermined domain identifier from the portable computer alien to the LAN to provide

to the portable computer data (column 17, lines 49-64 where the different domain identifier is

the gateway address of its home network);

Redlich does not teach that the data sent to the portable computer defines a page to be

displayed on the portable computer, the page being arranged to require entry of a private

'key' provided to the user of the portable computer only;

to receive the private 'key' when entered;

to maintain a record correlating the key with the MAC-address of the portable

computer; and

to generate a billing record indicative of times of usage of the LAN by the portable

computer identified by the recorded MAC-address.

33.   Levy teaches:

data sent to the portable computer defines a page to be displayed on the portable

computer, the page being arranged to require entry of a private 'key' provided to the user of

the portable computer only (abstract and column 2, lines 49-63);

to receive the private 'key' when entered (column 2, lines 59-63;

to maintain a record correlating the key with the MAC-address of the portable

computer (column 8, lines 10-16); and

to generate a billing record indicative of times of usage of the LAN by the portable

computer identified by the recorded MAC-address (column 7, line 60 to column 8, line 26).

It would have been obvious to one of ordinary skill in the art to implement Levy's

web page, security and billing functionality into Redlich's system to keep track of user

activity, insure secure access by an authorized user through the use of the private key and

web page, as well as keep track of the charges accumulated for easy billing.

34.   As to claim 18, Redlich teaches an apparatus for connecting a portable computer to a

LAN for which the portable computer is not configured comprising:

a LAN having a plurality of connection ports each for receiving connection to a

portable computer for data communication between the LAN and the portable computer

(Figure 8, items 400, 210, 410);

the LAN having a predetermined domain identifier for identification of computers

connected to the LAN (column 7, lines 45-61 and column 8, lines 35-41 – where the domain

name/corresponding IP address is the domain identifier).

a communication computer (abstract, Figures 9 and 10 – where the access router is the

communication computer);

the communication computer having a LAN connection connected to the LAN for

communication of data between the LAN and the communication computer (Figure 10 and

column 14, lines 20-48); and

the communication computer is further programmed:

to be responsive to the ARP request message using a domain identifier

different from the predetermined domain identifier from the portable computer alien

to the LAN to provide to the portable computer data (column 17, lines 49-64 where the

different domain identifier is the gateway address of its home network);

Redlich does not teach that the data sent to the portable computer defines a page to be

displayed on the portable computer, the page being arranged to require entry of a private

'key' provided to the user of the portable computer only;

to receive the private 'key' when entered;

to maintain a record correlating the key with the MAC-address of the portable

computer; and

to generate a billing record indicative of times of usage of the LAN by the portable

computer identified by the recorded MAC-address.

35. Levy teaches:

data sent to the portable computer defines a page to be displayed on the portable

computer, the page being arranged to require entry of a private 'key' provided to the user of

the portable computer only (abstract and column 2, lines 49-63);

to receive the private 'key' when entered (column 2, lines 59-63;

to maintain a record correlating the key with the MAC-address of the portable computer (column 8, lines 10-16); and

to generate a billing record indicative of times of usage of the LAN by the portable computer identified by the recorded MAC-address (column 7, line 60 to column 8, line 26). It would have been obvious to one of ordinary skill in the art to implement Levy's web page, security and billing functionality into Redlich's system to keep track of user activity, insure secure access by an authorized user through the use of the private key and web page, as well as keep track of the charges accumulated for easy billing.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art in regards to IP-based network services:

U.S Patent No. 6,130,892 to Short et al;

U.S Patent No. 6,286,039 to Van Horne et al;

U.S Patent No. 6,393,484 to Massarani.

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